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| 09/372,750 | 08/11/1999 | KENNETH BROWN | 3352-0102P | 1821 |

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| EXAMINER |
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ZURITA, JAMES H

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| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 07/08/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/372,750

Applicant(s)

BROWN ET AL.

Examiner

James Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-18 and 20-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-18, 20-31, 32-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Examiner rejected claims 1-31 on 23 January 2002 in a first office action on the merits. Applicants amended the application and drawings and filed an Information Disclosure Statement on 23 April 2002. Applicants cancelled claim 1, 10 and 19, added new claims 32-48, and traversed rejection of claims. Applicants traversed Examiner's rejections of remaining claims.

Applicants' arguments with respect to claims 1-9, 11-18 and 20-31 have been fully considered but they are not persuasive. Applicants' arguments with respect to claims have been considered but are moot in view of the new grounds of rejection.

Claims 1-9, 11-18, 20-31 and new claims 32-48 are pending; they will be considered for examination.

Response to Arguments

Applicants argue that Garfinkle fails to teach or suggest that images may be stored or displayed on a local station. Applicants also argue that one implementation of their invention does not require customers to store images on a network server before placing on-line orders, as in amended claim 28 and new claims 32, 37, 41, 46.

In response to these arguments, Garfinkle discloses that images may be stored at local machines prior to upload to an image server and prior to placing an order and that digital images may remain unprocessed until all data has been received at an image server. For example, "In a preferred embodiment, the digital images and

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associated information are stored in a single directory on a local machine of the photographer. . . . It will be appreciated that this design allows for communication between the scanning center of photographer and the image server to be interrupted at any time without causing a failure, since the digital images are not processed until [an entire set of images] is stored at the image server. . . ." (See at least Col. 4, lines 21-43). An entire set (i.e., multiple images, one+, a first, second, third, fourth, . . . nth image) may be stored and displayed on a user station and uploaded prior to placing an order). Therefore, applicants' argument is not persuasive.

Applicants argue that Garfinkle fails to teach or suggest (as in new claims 35, 39, 44 and 46) that a user station may display locally stored thumbnail images for which an on-line order is being placed. In response to this argument, Garfinkle discloses the use of thumbnail images in at least Col. 5, lines 10-28, Col. 6, line 56 - Col.7, line 15, Col. 8, line 8-19. Garfinkle discloses that thumbnail images on a server can be viewed from a local station with a NETSCAPE browser. While possibly physically smaller than their related image files, Thumbnail images are images, and Garfinkle has already disclosed that images may be stored on a local user station. Thus, thumbnail images may also be stored on a local user station. User stations have access to the Internet via a NETSCAPE browser. A user may also view thumbnail images on his station with the same browser that he used to view images on the server. Hence, users may display locally stored thumbnail images for which an on-line is being placed. Therefore, applicants' argument is not persuasive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-9, 11-18, 20-27, 32, 37, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto et al. (US Patent ,5,974,401)/*Enamoto*.

As per claims 32, 37 and 41, Enomoto discloses methods, programs and signals for on-line ordering of image-related services, comprising:

- receiving, at a user station, a digital image (see at least Col. 1, line 40-Col. 2, line 32 concerning the types of images that may be received and stored at a user station);
- establishing a network connection between said user station and an external network entity (see at least references to connections on networks, including the Internet, Col. 3, lines 21-30, See also at least references to web sites, Col. 6, lines 5-15);
- exchanging ordering information, between said user station and said external network entity, for an image-related service for said digital image (see at least Col. 2, lines 41-60); and
- uploading said digital image to said external network entity or another external network entity in accordance with the previously exchanged ordering information

(Col. 2, lines 23-60, which discusses that digital images are sent to an order receiver after order data is received).

As per claims 2, 11, 20, Enemoto discloses the use of digital photographic image(s) (see at least Col. 2, lines 10-32);

As per claims 3, 12, 21 and 9, 18, 27 Enemoto discloses a plurality of different sources for digital images, including image processing programs, a digital device interface application and a shell extension (see at least Col. 2, lines 10-31, which discusses that sources may include image input devices such as digital scanners, image scanner, computer graphics device and video capture. Enamoto also discusses the use of digital device interface applications in image processing programs and software; see at least Col. 3, lines 41-54. The software carries out different types of formatting and trimming, i.e., editing, of digital images, including image correction, etc. Commercially available image processing software may also include MICROSOFT PICTUREIT, as mentioned by applicant. Shells and shell extensions are well known in the computer arts, as described by applicants on page 3, lines 1-10, page 4, lines 10-15, 7, lines 7-16, page 8, lines 11-16. Shells for accessing files using operating system calls are well known, and may include MICROSOFT EXPLORER).

As per claims 4, 13, 22, Enamoto discloses that ordering information may include pricing. Enamoto discusses that orders may be executed after a user confirms date and charges for an order. Enamoto also discloses that orders may be fulfilled as different types of print sizes and quantity. Enamoto also discloses that images may be produced on merchandise other than prints, such as post cards.

As per claims 5, 14 and 23, Enemoto discloses that an external network entity may include at least one of a server, photofinishing lab and third-party fulfillment house (see references to network, above. Networks inherently have clients and servers. For photofinishing, see at least Col. 1, lines 40-67).

As per claims 6, 15, 24 Enemoto discloses that an image-related service generates at least one of photographs and merchandise with photographs imprinted thereon (Col. 5, lines 11-29; Col. 7, lines 53-60; Col. 10, lines 9-27).

As per claims 7, 16 and 25, Enamoto shows that one may first send pre-order data to an order receiver, and follow this by sending image data (see at least Col. 2, lines 40-58).

As per claims 8, 17 and 26, Enamoto discloses various processes for checking and improving quality of digital images, including editing, formatting, image correction, color correction and format (see at least Col. 2, lines 10-32, Col. 3, lines 32-60, which discusses types of editing routines and formatting of digital images).

Thus, Enamoto describes methods, system and network for on-line ordering, fulfilling and delivering products such as photographic prints based on customer orders. Enamoto also describes that ordering may take place prior to uploading images to the system from a user station, where they are first stored. Enamoto includes functions such as exchanging, storing, sending/receiving, displaying, connecting, ordering, uploading digital image information and producing products from the information.

Enamoto does not specifically use the term "code segment" when describing the different functions of his invention. However, it is well known that in computer systems,

functions are implemented with computer code. The functions code may be called programs, modules, applets, executables, load modules, code segments, scripts, etc.

Enamoto does not specifically name other types of image-related services provided by an order receiver server. Examiner takes official notice that it is well known to place images, including digital photographic images, on products such as mugs and T-shirts.

Therefore, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time the invention was made to apply Enamoto's on-line digital print order and delivery system and include code segments for printing digital photographic images on other types of products, including gifts and merchandise.

One of ordinary skill in the art of electronic commerce at the time the invention was made would have been motivated to combine Enamoto's on-line digital print order and delivery system and include code segments for printing digital photographic images on other types of products, including gifts and merchandise for the obvious reason that customers often enjoy having images of loved ones on T-shirts, cups and other items. Personalization and customization of merchandise greatly enhances customer appreciation for loved ones, and there is a great demand for such gifts and products, which in turn benefits commerce because items are sold and purchased.

Claims 28-31, 33-36, 38-40, 42-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Garfinkle (US Patent 6,017,157)/*Garfinkle*.

As per claim 28 (amended) Enamoto discloses a network photo print system comprising:

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- a user station, capable of running a camera/scanner applications program for supplying first image data to a user station (see at least Col. 1, line 40-Col. 2, line 32);
- a photo editing application program for supplying second image data to a user station (see at least Col. 3, lines 41-54; the software carries out different types of formatting and editing of digital images, including image correction, etc.

Enamoto also discusses digital device interface applications in image processing programs and software, see also at least rejection of claims 3, 9, above);

- an operating system, including an operating system desktop shell interface and an extension to an operating system desktop shell interface (see applicants prior art disclosures, claim 3. Examiner takes official notice shell extensions and shells access operating system commands via on their own or with application interfaces);
- a network access protocol module capable of receiving any one of a first, second, and third image data, receiving order information and merchandise availability information from an external network entity (see at least Col. 2, lines 40-60, where Enamoto discloses that print sizes and print formats may be available or not available at a fulfillment center such as a photo-finisher. See also rejection of claims 4 and 32, above, concerning network access on the internet, which Transmission Control Protocol to allow access and transfer of data across networks);

- processing an order based on any one of a first, second, and third image data, and outputting any one a first, second, and third image data (see at least Col. 5, lines 43-65, concerning processing of orders and outputting various images).
- a network sales/order processing server for receiving an order and for receiving any one a first, second, and third image data image data from a user station after receiving an order (see at least references to order receiver that receives images, order request information and produces prints, Col. 1, lines 51-Col. 2, line 32); and
- a photofinishing lab for producing photographic-quality print images based on an order and any one a first, second, and third image data from a network sales/order processing server (see at least references to photo-finisher, Col. 3, lines 10-53, Col. 8, lines 42-53).

As per claims 28 and 30, Enamoto discloses a network photo print system for placing, processing and fulfilling orders. As per claims 29 and 31, Enamoto discloses use of the Internet and World Wide Web sites to connect users and servers.

As per claims 28 and 30, Enamoto does not specifically use the word "shell" to describe access of a first, second, third or nth image. Enamoto also does not specifically disclose that an extension to an operating system desktop shell interface permits a user of a user station to initiate an order directly from a system file level of the operating system without invoking an additional application program.

As per claim 29, Enamoto does not specifically disclose that a network access protocol module delays outputting an image and its data to a server until an order for a

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plurality of images is complete. As per claim 31, Enamoto does not specifically disclose plug-in modules.

It is well known that shells and shell extensions of an operating system may be used to access digital images from a file system (see at least rejection of claim 3 and references to applicant's prior art disclosures). With shells, one may access file system commands to move one or more files to/from various directories for use by application programs and interfaces. When software is written, it is common practice to make use of operating system calls for file access and I/O processes, etc. Shell programming and extensions are well known in the art. For example, various e-mail user agent programs use operating system shells and extensions for attaching files to e-mail messages.

It is also well known that the WWW is accessible via a network access protocol called Transmission Control Protocol/Internet Protocol, TCP/IP for short. TCP/IP and WWW include a family of plug-in's, modules and protocols such as File Transfer Protocol, Telnet. One may include time delays using JAVASCRIPT, JAVA, or their MICROSOFT equivalent. For example, a user may click on a Web page object to initiate actions that may be delayed by applets or JAVASCRIPT.

As per claims 28-31, Garfinkle discloses the use of file systems and directories (see at least Col. 5, lines 63-67; Col. 6, lines 37-49, describing directories and file such as images stored in JPEG format). Garfinkle describes the use of plug-in modules (see at least Col. 5, lines 1-10). Garfinkle discloses the use of file systems and directories (see at least Col. 5, lines 63-67; Col. 6, lines 37-49, describing directories and file

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systems that may exist in various shell extensions and may hold JPEG and other type of digital images).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Enamoto and Garfinkle and well known information about the WWW to include accessing multiple images, using shell interfaces and plug-ins, and delaying outputting an image and its data to a server until an order for a plurality of images is complete.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Enamoto and Garfinkle and well known information about the WWW to include accessing multiple images, using shell interfaces and plug-ins, and delaying outputting an image and its data to a server until an order for a plurality of images is complete for the obvious reason that shells, plug-ins are widely used on Internet browsers. In addition, it is well known and common to delay upload of images and to upload them in batches because of shortened transmission times, reduced utilization of resources.

As per claims 35, 39, 44, claims 36, 40 45, and claims 46, 47, Enamoto discloses storing images on a user's machine and sending images to a server while sending ordering information to the server.

As per claims 35, 36, 39, 40, 44, 45, 46 and 47, however, Enamoto does not specifically disclose the use of thumbnail images.

As per claims 34, 43, 48, Enamoto does not specifically disclose the use of a shell extension of an operating system to access digital image from a file system.

Garfinkle discloses the use of thumbnail images corresponding to any one of a plurality of images, and sending orders to a network sales/order processing server (see at least Col. 5, lines 10-30, Col. 6, line 56-Col. 7, line 15, Col. 8, lines 8-19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to disclose the use of thumbnails in a order and fulfillment system. One of ordinary skill in the art at the time the invention was made would have been motivated to include the use of thumbnails in a order and fulfillment system for the obvious reason that by providing thumbnail images, it is possible for users to see more data on a screen and focus on the ones they select. In addition, by providing thumbnail images, a server may cut down on transmission time and storage prior to selection by a user. Thumbnail images may be stored and transferred across networks in manners similar to regular sized images.

As per claim 46 (New) Enamoto discloses displaying on a user station one or more image(s) stored on the local user station. Since thumbnail images are another type of image, the combination of Enamoto and Garfinkle disclose displaying one or more thumbnail image(s).

As per claims 36, 40, 45, 46 and 47, relating to pointers to thumbnail image(s), Enamoto and Garfinkle do not disclose sending to a server pointer(s) to image(s), including thumbnail images, that are stored on a local user station.

As per claim 47, Enamoto and Garfinkle do not disclose that a network access protocol module sends said network sales/order processing server a pointer to a thumbnail image locally stored at said user station.

Pointers are variables that contain information concerning logical or physical location of some data rather than the data itself. Data may be stored in various types of files and in many formats, including image files (such as JPEG digital photography and thumbnail image files). Applicants describe operating systems and file systems well known to those of ordinary skill in the art of electronic commerce. These O/S include WINDOWS 95, WINDOWS NT. See at least application, page 7, lines 11-13, and page 8, lines 19-21; on at least page 1, lines 13-16. For information necessary to locate a file, see at least applicants Fig. 5, and related text. While some file systems may require additional information, it is well known that with MICROSOFT WINDOW EXPLORER, one may locate a file by providing a directory name and the file's name within the directory, as shown in Fig. 5. An operating system shell would then be able to locate and access the data contained in a file, including a digital photography image file and a thumbnail image file.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Enamoto, Garfinkle, with knowledge generally available and disclose the use pointers (such as directory name and file name within a directory) to thumbnail images locally stored at a user station.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Enamoto, Garfinkle, with knowledge generally available and disclose the use pointers (such as directory name and file name within a directory) to thumbnail images locally stored at a user station for the obvious reason that providing pointers to thumbnail images stored on a user station allows a transaction to take place

with smaller amounts of information being sent across a network. This decreased exchange of data permits reduced transmission time and reduced bandwidth utilization. All users of an electronic commerce system benefit, since the order information that needs to be sent across networks can be made up of text data exclusively. A list of pointers may be verified more easily at both client and server sites. In addition, a local user need not send image data itself until a full order has been agreed upon.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8:30 am to 5:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular and After Final communications.

JZ
James Zurita
Patent Examiner
Art Unit 3625
June 28, 2002


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